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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,535	02/16/2001	Norman H. Margolus	11656-002001	5190
26161 7590 05/03/2007 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022				
			EXAMINER PHAM, HUNG Q	
			ART UNIT 2168	PAPER NUMBER
			MAIL DATE 05/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/785,535

Applicant(s)

MARGOLUS ET AL.

Examiner

HUNG Q. PHAM

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 7, 8, 10, 12, 14, 15, 20, 26, 28-31, 33, 38, 40, 41, 43, 44, 48, 55, 60, 66, 67, 154, 175, 178, 179, 183-185, 187, 188 and 190-192 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1,4,7,8,10,12,14,15,20,26,28-31,33,38,40,41,43,44,48,55,60,66,67,154,175,178,179,183-185,187,188 and 190-192.

3DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/21/06 has been entered.

Response to Arguments

- The rejections of claims 1 and 178 under 35 U.S.C. § 112, first and second paragraph, have been withdrawn in view of the amendment.
- The rejection of claims 1, 4, 7, 8, 10, 12, 14, 15, 20, 26, 28-31, 33, 38, 40, 41, 43, 44, 48, 55, 60, 66, 67, 154, 175, 178, 179, 183-185, 187, 188 and 190-192 under 35 U.S.C. § 103 has been withdrawn in view of the amendments.

Claim Objections

Claim 55 is objected to because of the following informalities: *The method of claim 54* (claim 54 has been canceled). Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 10, 15, 31, 40, 41, 43, 55, 187 and 188 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the clause, *the stored data item* (Lines 32 and 36), references to the clause *a stored data item* (Line 19). However, the step of retrieving (Lines 32-37) is based on the properties of the deposited data item (Lines 26-31) after storing (Lines 21-23). It is unclear what data item is retrieved in claim 1, e.g., data item at Line 19 or the deposit data item after storing at Lines 21-23.

The clause *the stored data item* in claims 31, 187 and 188 is also rejected with the same reason.

Regarding claims 10, 15 and 41, the clause *the data item* references to other data item in the claims. It is unclear what data item is being referenced.

Regarding claims 40 and 43, the clause *the deposit* (Line 2) references to other data item in the claims. It is unclear what data item is being referenced.

Art Unit: 2168

Regarding claim 55, the clause *the component data-items* references to other data item in the claims. It is unclear what data item is being referenced.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 4, 7, 8, 10, 12, 14, 15, 20, 26, 28-31, 33, 38, 40, 41, 43, 44, 48, 55, 60, 66, 67, 154, 175, 178, 179, 183-185, 187, 188 and 190-192 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim(s) 1, 4, 7, 8, 10, 12, 14, 15, 20, 26, 28-31, 33, 38, 40, 41, 43, 44, 48, 55, 60, 66, 67, 154, 175, 178, 179, 183-185, 187, 188 and 190-192, especially claim 1, are directed to a method by which more than one client program connected to a network. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a tangible result. Specifically, the claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for retrieving the stored data item (Line 32) only if comparing establishes that there is no match (Lines 21-23). Otherwise, not storing the deposited data item if a match is found and the method is stopped after not storing (the steps associating and retrieving (Lines 26-37 are not implemented because of this

Art Unit: 2168

conditional statement). This produced result, not storing the deposited data item, remains in the abstract and, thus, fails to achieve the required status of having real world value.

Allowable Subject Matter

Claims 1, 4, 7, 8, 10, 12, 14, 15, 20, 26, 28-31, 33, 38, 40, 41, 43, 44, 48, 55, 60, 66, 67, 154, 175, 178, 179, 183-185, 187, 188 and 190-192 would be allowable if rewritten or amended to overcome the objection and rejection(s) under 35 U.S.C. 101 and 112, 2nd paragraph, set forth in this Office action.


Art Unit: 2168

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TIM T. VO can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


HUNG Q PHAM
Examiner
Art Unit 2168

April 24, 2007